

REMARKS

Applicants respectfully request consideration of the subject application as amended herein. This Amendment is submitted in response to the Office Action mailed April 14, 2006. Claims 92-112, 115-119 and 161-168 are rejected.

The Examiner has rejected claims 92-94, 98-102, 108-112, 115, 119 and 161-163 under 35 U.S.C. §103(a) as being unpatentable over Chang, et al. (USPN 6,118,864, "Chang") in view of Guy, et al. (USPN 5,940,479, "Guy"), Binkerd, et al. (USPN 4,623,760, "Binkerd") and Meubus, et al. (USPN 5,793,858, "Meubus").

The Examiner has rejected claims 95-97, 103-105, 116-118 and 164-166 under 35 U.S.C. §103(a) as being unpatentable over Chang in view of Guy, Binkerd and Meubus and further in view of English, et al. (USPN 5,305,308, "English").

The Examiner has rejected claims 106-107 and 167-168 under 35 U.S.C. §103(a) as being unpatentable over Chang in view of Guy, Binkerd and Meubus and further in view of Fuentes (USPN 5,812,541) or Lowry, et al. (USPN 5,970,066, "Lowry").

In independent claims 92, 100, 108 and 161, applicants claim a configurable timer. With respect to this limitation, the Examiner states that Chang discloses "starting an inherent timer for measuring a time period that the second ring signal is applied (Figure 5B, step 148; note: ring-no-answer)." (Office Action dated 04/14/06, p. 4, ¶5). Examiner further states that "Chang provides a RNA determination within a packet data network and Meubes discloses in the same

field of endeavor that a RNA duration is specified, where the duration allows a user an amount of time to answer the phone as is known in the art.” (Office Action dated 04/14/06, p. 3, ¶3).

In the portions referred to by the Examiner, Chang reads as follows:

If at 144, through call progress analysis the remote communication platform receives a ring-no-answer or busy status rather than a live answer status, step 148 is performed. At step 148, if the predetermined memory location indicates that ring-no-answer forward or busy forward is not specified, step 150 is performed.

(Chang, col. 16, lines 22-27).

Thus, Chang discloses performing call progress analysis to determine if an outbound call is answered by a live person, ring-no-answer signal or busy signal by using frequency and cadence of audio signals and tones, such as those of disconnect tones. Thus, Chang does not teach or suggest the use of a “configurable timer”, as claimed. However, Meubes discloses a timer. However, the Examiner has not provided a motivation for combining the disclosure of Chang, Guy, and Binkerd, with the timer disclosed in Meubes. Indeed, such a four-reference combination would be based on impermissible hindsight based on applicants’ own disclosure.

Further, applicants object to the Examiner’s position that a timer is inherent in Chang’s disclosure. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a

certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Applicants respectfully submit that the examiner has not "provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Further, applicants respectfully submit that the Chang, Guy and Binkerd, either individually or in combination, do not teach or suggest creating an "on-hook" signal at a telephone interface maintained by the system as a consequence of the system having received said control message over the packet data network.

With respect to this limitation, the Examiner states:

Chang in view of Guy does not disclose ... generating an on-hook signal at the telephone interface. Binkerd discloses providing ... an on-hook signal to a telephone interface to indicate the status of a line (Figure 1, items 102 and 109; Figure 23, timing diagram 2501-25-2; col. 16, lines 38-42 and col. 25, lines 52-68). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to generate ... an on-hook signal at the telephone interface in the invention of Chang in view of Guy in order to communicate the line status between devices to indicate a call has been ended or disconnected as is known in the art.

(Office Action dated 04/14/06, p. 4-5, ¶7).

The Office Action has provided inadequate motivation to combine the cited references under 35 USC § 103. The motivational reason given to combine Chang in view of Guy and Binkerd was "to communicate the line status between devices to indicate a call has been ended or disconnected." (Office Action dated 04/14/06, p. 4-5, ¶7). The office action cites no hints or

suggestions in any of the references that actually suggests the combination of these references. The reasoning provided does not make particular findings of fact as to why a person skilled in the art of communication systems design would find the suggestion to creating an “on-hook” signal at a telephone interface maintained by the system as a consequence of the system having received said control message over the packet data network. The applicant requests a specific citing of facts to establish a prima facie case of obviousness by a preponderance of the evidence under 35 USC § 103.

The law requires to prevent the use of hindsight an examiner “must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998.) (emphasis added) (Also see MPEP 2142 as well as MPEP 2145). The PTO bears the burden of proving an obviousness type rejection based on findings of fact and not based on conclusive statements. In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999). The patent examiner must cite sufficient facts to meet the evidentiary standard of a prima facie case of obviousness by a preponderance of the evidence under 35 USC § 103 rather than a mere obvious to try standard. Ex parte Hillyer, 68 USPQ2d 1222, 1224 (Fed. Cir. 2003). Adequate findings of fact can come from several sources. Dembiczak at 996. The motivation to combine reference must be found in the cited references themselves. Id. Alternatively, the PTO may establish that one of ordinary skill in the art would have been motivated to combine the references with articulated findings of fact regarding: 1) the level of skill in the art; 2) the relationship between the fields of the cited art; and 3) the particular features of the prior art references that would motivate one of ordinary skill

in applicant's particular art to select elements disclosed in references from a wholly different field. Id.

"Our [Federal circuit] case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002). (emphasis added) "Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet's [Appellant's] invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight." Rouffet at 1359 (emphasis added) "The Board must, inter alia, show some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that an individual to combine the relevant teachings of the references." In re Thrift, 298 F.3d 1357, 1361 (Fed. Cir. 2002) (emphasis added). The Federal Circuit gives guidance that the technological motivation to combine the references should be present in the text or drawings of each reference. Id. "Otherwise, the law infers that the examiner selected these references with the assistance of hindsight." See In re Rouffet.

The Examiner did not cite in either of the references where one skilled in the art of processor design would find the suggestion to generate an on-ring signal for the interface in Chang. Therefore, on this basis alone, applicants respectfully submit impermissible use of hindsight has occurred and the obviousness rejection of claims 92, 100, 108, and 161 and associated dependent claims has been over come.

In conclusion, applicants respectfully submit that in view of the arguments an set forth herein, the applicable rejections and objections have been overcome.


If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Lester J. Vincent at (408) 720-8300.

If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

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